processor determines whether the read manufacturer identification information matches a code of a current reproducing apparatus relating to a manufacturer of the current reproducing apparatus, controls the optical pickup to read the content if there is a match for reproduction of the content, controls the optical pickup to read the content if there is not the match for analyzing the content, and reproduces the content if there is the match or if the analysis indicates the content is reproducible by the current reproducing apparatus.

## REMARKS

### INTRODUCTION:

In accordance with the foregoing, claims 4-6, 31-37, and 39 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 4-10 and 15-46 are pending and under consideration.

### ENTRY OF AMENDMENT UNDER 37 C.F.R. § 1.116:

Applicants request entry of this Rule 116 Response because the amendments of claims 4-6, 31-37, and 39 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### REJECTION UNDER DOUBLE PATENTING:

In the Office Action, at page 6, claims 4-5, 7-10, 15-23, 28, 31-38, and 40-45 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 1-2, 15-17, 20-21, 24-25, 27, and 45 of copending application

No. 09/337,253, parent application of the above-referenced application. Further, claims 6, 24-27, 29-30, and 39 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 1-2, 15-17, 20-21, 24-25, and 27 of copending application No. 09/337,253 in view of U.S. Patent No. 5,758,355 to Buchanan. Claims 4-10 and 15-45 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 11-38 of copending application No. 9/610,696, divisional application of the above-referenced application. Applicants will address the provisional obviousness-type double patenting rejections once the pending rejections to the claims are resolved.

**REJECTION UNDER 35 U.S.C. § 103:**

*In the Office Action, at page 25, claims 4-10, 16-30, 40-44, and 46 were rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 6,038,366 to Ohno et al. ("Ohno") in view of U.S. Patent No. 5,758,355 to Buchanan ("Buchanan"). This rejection is traversed and reconsideration is requested.*

The Office Action correctly recognized that Ohno fails to teach or suggest "wherein the manufacturer information comprises an identification information of a manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification," as recited in independent claim 4. Accordingly, the Office Action relies on Buchanan as teaching such a claimed feature.

Buchanan generally describes a server including a plurality of tables, which is accessible on a server computer system. See abstract. The server includes storage media encoded with the server database. See column 4, lines 22-26. According to Buchanan, company records, for example, may indicate not only which companies are associated with a particular team, but also may identify records in a contact table that specify the contact persons at the company. See column 2, lines 33-37. The Contact Table of Buchanan includes contact id., first name, last name, company id., row id., modify date, and modify employee. See column 8, lines 40-50. However, similarly to Ohno, Buchanan fails to teach or suggest "manufacturer information to support a manufacturer's specific function, wherein the manufacturer information comprises an **identification information of a manufacturer of a recording apparatus**," emphasis added, as recited in independent claim 4. Rather, the Contact Table appears to merely list employees of different companies modifying a company's records. There is no teaching or suggestion in

Buchanan that the Contact Table stores "identification information of a manufacturer of a recording apparatus," as recited in independent claim 4. The identification information includes employees modifying records that are related to a team for which an associated remote employee is included. See column 7, lines 47-52. Furthermore, Buchanan fails to teach or suggest "wherein the manufacturer information comprises an identification information of a manufacturer of a recording apparatus **that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification**," emphasis added, as recited in independent claim 4.

Accordingly, Buchanan and Ohno, individually or combined, fail to teach or suggest all the claimed features of independent claim 4 and related dependent claims. It is respectfully asserted that independent claims 1 and related dependent claims are allowable in view of the prior art of record.

Without adequate support from Ohno and/or Buchanan of a need or motivation to achieve an efficient system operation in Ohno, the Office Action indicates that "it would have been obvious to one of ordinary skill in the art at the time of the invention to the identification as taught by Buchanan into Ohno's system in order to achieve efficient system operation in Ohno by allowing user to know who modif[ied] the content of record." Rather than using the teachings of the cited references, the Office Action combines the references by disregarding current case law regarding the standard of an obviousness rejection under 35 U.S.C. § 103.

It is improper to merely deem something obvious without any teaching/suggestion from the cited references. As applied to the determination of patentability when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), (citing In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See In re Lee, 61 USPQ2d 1430 (CA FC 2002), (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("The central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors). Accordingly, evidence must be

provided from the prior art of some teaching, motivation, or suggestion to select and combine the references.

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

It is the Applicants' position that only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken the teachings of the present invention and applied the same to generate a combination of Ohno and Buchanan as set forth in the Office Action.

In view of the foregoing, it is respectfully requested that independent claim 4 and related dependent claims be allowed. Furthermore, the Office Action refers to similar portions of the cited references to reject independent claims 7, 8, 10, and 28 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 4. The arguments presented above supporting the patentability of independent claim 4 in view of Ohno and/or Buchanan are incorporated herein to support the patentability of independent claims 7, 8, 10, and 28. Accordingly, Ohno and/or Buchanan, individually or combined, fail to teach or suggest all the claimed features of independent claims 4, 7, 8, 10, and 28. It is respectfully requested that independent claims 4, 7, 8, 10, and 28 and related dependent claims be allowed.

*In the Office Action, at page 32, claims 15, 31-39. and 45 were rejected under Ohno in view of Buchanan and further in view of U.S. Patent No. to Yokota ("Yokota"). This rejection is traversed and reconsideration is requested.*

Independent claim 31 recites, "a processor to reproduce manufacturer identification information of the apparatus that recorded or modified the content based upon the read manufacturer identification information different from the manufacturer identification information prior to the recording or the modification." The Office Action refers to similar portions of the cited references to reject independent claim 31 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 4. The descriptions of Ohno and Buchanan provided above and the arguments presented above supporting the patentability of independent claim 4, for instance, are incorporated herein to support the patentability of independent claim 31.

Yokota generally describes a recording medium including a recording area, a first managing data area and a second managing area. See abstract. In the recording area are recorded only audio data, or an intermixture of audio data and video data. However, similar to Ohno and Buchanan, Yokota is silent as to providing "a processor to reproduce manufacturer identification information of the apparatus that recorded or modified the content based upon the read manufacturer identification information different from the manufacturer identification information prior to the recording or the modification," as recited in independent claim 31. Rather, Yokota generally describes managing areas where managing data is recorded for controlling a recording or reproducing operation of audio data for the recording area when only the audio data is recorded in or reproduced from the recording area or when both of audio data and video data are recorded in or reproduced from the recording area. See column 2, lines 9-18. Yokota fails to teach or suggest all the claimed features of independent claim 31.

Accordingly, Ohno, Buchanan, and/or Yokota, individually or combined, fail to teach or suggest all the claimed features of independent claim 31. It is respectfully requested that independent claim 31 and related dependent claims be allowed.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: May 28, 2003

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Please AMEND claims 4-6, 31-37, and 39. The remaining claims are reprinted, as a convenience to the Examiner, as they presently stand before the U.S. Patent and Trademark Office.

4. (TWICE AMENDED) A recording and/or reproducing apparatus for recording and/or editing content on a [rewritable] recording medium, comprising:

a recording controller to record manufacturer information to support a manufacturer's specific function,

wherein the manufacturer information comprises an identification information of the manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification.

5. (TWICE AMENDED) The recording and/or reproducing apparatus of claim 4, wherein the manufacturer information further comprises an identification information of a product that modified the content of the recording medium.

6. (ONCE AMENDED) The recording and/or reproducing apparatus of claim 4, wherein the manufacturer information has a maximum number of manufacturer information items, and if the number of manufacturer information items exceeds the maximum number of manufacturer information items, then the recording controller deletes an oldest one of the manufacturer information items.

7. (AS ONCE AMENDED) A recording apparatus to record content on a recording medium, comprising:

a device to record a manufacturer identification information of the recording apparatus on the recording medium in response to the recording apparatus modifying the content, wherein the manufacturer information comprises an identification information of the manufacturer of the recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification.

8. (AS ONCE AMENDED) A reproducing apparatus for reproducing content, including audio, video, and/or information data, from a rewritable recording medium, comprising:

a reproducing controller to reproduce the content, formatted information for the content and manufacturer information to support a manufacturer's specific function,

wherein the manufacturer information comprises an identification information of the manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification.

9. (AS ONCE AMENDED) The reproducing apparatus of claim 8, wherein the manufacturer information further comprises a product identification information of the recording apparatus that modified the content of the recording medium.

10. (AS ONCE AMENDED) A reproducing apparatus to reproduce content and information on a recording medium, comprising:

a device to check an identification information of a manufacturer and an identification information in the information recorded on the recording medium to determine a manufacturer that recorded or modified the content on the recording medium different from the identification information prior to the recording or the modification.

15. (AS ONCE AMENDED) The recording apparatus of claim 7, wherein the device comprises:

a coder to compression-code an A/V signal according to a predetermined compression scheme;

a signal processor to modulate the compression-coded A/V signal;

a radio frequency amplifier to convert the modulated signal into a radio frequency signal;

an optical pickup to record the radio frequency signal as the manufacturer identification information on the recording medium;

a servo unit to control servo of the optical pickup based upon read signals from the radio frequency amplifier; and

a system controller to control the coder, the signal processor, the optical pickup, and the servo unit.

16. (AS ONCE AMENDED) The recording apparatus of claim 7, wherein the device records a product information code indicating a product model of the recording apparatus that modified the content of the recording medium on the recording medium.

17. (UNAMENDED) The recording apparatus of claim 16, wherein the device records an operation code indicating information on an operation performed by the recording apparatus other than reproduction on the content on the recording medium.

18. (UNAMENDED) The recording apparatus of claim 17, wherein the operation code information is compatible for a plurality of different manufacturers.

19. (UNAMENDED) The recording apparatus of claim 7, wherein the device records a manufacturer information item specific to the manufacturer, and a manufacturer code to indicate the manufacturer of the manufacturer information item.

20. (UNAMENDED) The recording apparatus of claim 16, wherein the device records a manufacturer information item specific to the manufacturer, a manufacturer code to indicate the manufacturer of the recording apparatus of the manufacturer information item, and a product code to indicate a product model of the recording apparatus of the manufacturer information item.

21. (UNAMENDED) The recording apparatus of claim 20, wherein the device records time information indicating a time when the manufacturer information item is recorded on the recording medium.

22. (UNAMENDED) The recording apparatus of claim 20, wherein the device records the manufacturer codes and the product codes at a beginning part of the manufacturer information item.

23. (UNAMENDED) The recording apparatus of claim 19, wherein the device records a search pointer indicating a starting address of the manufacturer information item.

24. (UNAMENDED) The recording apparatus of claim 19, wherein the device updates a number of total manufacturer information items recorded on the recording medium.

25. (UNAMENDED) The recording apparatus of claim 24, wherein the recording apparatus determines whether the number exceeds a predetermined limit, and if so, deletes an oldest manufacturer information item stored on the recording medium.

26. (AS ONCE AMENDED) The recording apparatus of claim 16, wherein the device records a last address of manufacturer information which includes the manufacturer identification information and the product information code.

27. (AS ONCE AMENDED) the recording apparatus of claim 17, wherein the device records a last address of manufacturer information which includes the manufacturer identification information, the product code, and the operation code.

28. (AS ONCE AMENDED) A recording and/or reproducing apparatus to record and/or reproduce content on a recording medium, comprising:

a recorder to record on the recording medium a manufacturer identification information of the recording and/or reproducing apparatus indicating a manufacturer of the recording and/or reproducing apparatus as the one to record or modify the content of the recording medium different from the identification information prior to the recording or the modification; and

a reproducer to read the manufacturer identification information, determine whether the content is effective based upon whether the read manufacturer identification information matches that of the recording and/or reproducing apparatus, and read the content if the content is effective.

29. (UNAMENDED) The recording and reproducing apparatus of claim 28, wherein if the reproducer determines that the read manufacturer identification information does not match that of the recording and reproducing apparatus, the reproducer reads the content of the recording medium to determine whether the content is effective.

30. (UNAMENDED) The recording apparatus of claim 4, wherein the manufacturer information further comprises a manufacturer information item specific for the manufacturer of the recording apparatus, wherein the recorder updates only the manufacturer information item and does not update other manufacturer information items already recorded on the recording medium.

31. (TWICE AMENDED) A reproducing apparatus to reproduce content from a recording medium on which a manufacturer identification information of a manufacturer of an apparatus that modified the content of the recording medium, the reproducing apparatus

comprising:

an optical pickup to read the manufacturer identification information; and

a [reproducer] processor to reproduce [make a first determination of the manufacturer] [a] manufacturer identification information of the apparatus that recorded or modified the content based upon the read manufacturer identification information different from the manufacturer identification information prior to the recording or the modification[, and make a second determination whether the optical pickup is to read the content based upon the first determination].

32. (TWICE AMENDED) The reproducing apparatus of claim 31, wherein the [reproducer] processor comprises:

a radio frequency amplifier to convert an optical signal of the read manufacturer identification information and the read content to an electrical signal and extracts a servo signal from the optical signal;

a signal processor to perform error correction coding and demodulate the optical signal;

a decoder to decode the error corrected demodulated signal;

a servo unit to control servo of the optical pickup based upon the servo signal; and

a system controller to control the radio frequency amplifier, the signal processor, the decoder, and the servo unit.

33. (ONCE AMENDED) The reproducing apparatus of claim 31, wherein the recording medium has a product information code indicating a product model of the apparatus that modified the content of the recording medium on the recording medium, the optical pickup reads the product model, and the [reproducer] processor determines whether to read the content based upon the read product model.

34. (TWICE AMENDED) The reproducing apparatus of claim 31, wherein the recording medium has an operation code indicating information on an operation performed by the recording apparatus that modified the content of the recording medium, the optical pickup reads the operation code and the [reproducer] processor determines how to modify the content based upon the read operation code.

35. (ONCE AMENDED) The reproducing apparatus of claim 33, wherein the recording medium has a manufacturer information item specific to the manufacturer, and a

manufacturer code to indicate the manufacturer of the manufacturer information item, wherein the optical pickup reads the manufacturer code and the [reproducer] processor determines whether to read the manufacturer information item if the manufacturer code matches a code relating to the manufacturer of the reproducing apparatus.

36. (ONCE AMENDED) The reproducing apparatus of claim 33, wherein the recording medium has a manufacturer information item specific to the manufacturer, a manufacturer code to indicate the manufacturer of the recording apparatus of the manufacturer information item, and a product code to indicate a product model of the recording apparatus of the manufacturer information item, wherein the optical pickup reads the manufacturer code and the product code, and the [reproducer] processor determines whether to read the manufacturer information item if the manufacturer code matches a code relating to the manufacturer of the reproducing apparatus and the product code matches a code relating to the product model of the reproducing apparatus.

37. (ONCE AMENDED) The reproducing apparatus of claim 36, wherein the recording medium has time information indicating a time when the manufacturer information item is recorded on the recording medium, the optical pickup reads the time information and the [reproducer] processor processes the read time information.

38. (UNAMENDED) The reproducing apparatus of claim 35, wherein the recording medium has a search pointer indicating a starting address of the manufacturer information item, the optical pickup reads the search pointer and then reads the manufacturer information item at the starting address thereof.

39. (TWICE AMENDED) The reproducing apparatus of claim 31, wherein the [reproducer] processor determines whether the read manufacturer identification information matches a code of a current reproducing apparatus relating to a manufacturer of the current reproducing apparatus, controls the optical pickup to read the content if there is a match for reproduction of the content, controls the optical pickup to read the content if there is not the match for analyzing the content, and reproduces the content if there is the match or if the analysis indicates the content is reproducible by the current reproducing apparatus.

40. (UNAMENDED) The recording apparatus of claim 4, wherein the identification

information of the manufacturer corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

41. (UNAMENDED) The recording apparatus of claim 7, wherein the identification information of the manufacturer corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

42. (UNAMENDED) The reproducing apparatus of claim 8, wherein the identification information of the manufacturer corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

43. (UNAMENDED) The reproducing apparatus of claim 10, wherein the identification information of the manufacturer corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

44. (UNAMENDED) The recording and reproducing apparatus of claim 28, wherein the manufacturer identification information corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

45. (UNAMENDED) The reproducing apparatus of claim 31, wherein the manufacturer identification information corresponds to the manufacturer of the recording apparatus that last modified the content of the recording medium.

46. (UNAMENDED) The recording apparatus of claim 4, wherein when the identification information of the recording apparatus which modified the recording medium is the same as an identification information for the current recording apparatus and the editing is complete, the manufacturer information item is updated by analyzing the content of the manufacturer information item corresponding to the modified content to determine whether the manufacturer information item for the manufacturer is effective to perform the recording, the modification, and/or reproduction.